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09/867,631	05/31/2001	Timothy Mark Morris-Yates	169.2063	7181

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NEW YORK, NY 10112

EXAMINER

VU, KIEU D

ART UNIT PAPER NUMBER

2173

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/867,631

Applicant(s)

MORRIS-YATES, TIMOTHY MAR

Examiner

Kieu D Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-64 are pending.
2. The IDS filed 09/24/02 and 11/19/03 are considered.
3. The Priority Document filed 11/20/03 is acknowledged.

***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

reference sign 406 in Fig. 4,  
reference signs 530, 502, and 504 in Fig. 5,  
reference sign 634 in Fig. 6,  
reference sign 736 in Fig. 7, and  
reference sign 1100 in Fig. 10.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The specification is objected since it contains a typographical error.  
In page 19, line 5; the second period after "frequency" should be deleted.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 23-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since claim 23 claims "A computer program" per se and does not positively recite that the program is stored on a medium that can be read by a machine. As such, the claimed invention is not directed to a machine readable medium or a manufacturer article.

Claims 24-41 depend on claim 23 so claims 24-41 are rejected on the same rationale.

Claims 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since claims 42-43 claims "A computer program product" per se and does not positively recite that the program is stored on a medium that can be read by a machine. As such, the claimed invention is not directed to a machine readable medium or a manufacturer article.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14-16, 36-38, and 57-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said preview" in line 3. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 7 or "a pop-up preview" of claim 1. Therefore, the claim is vague and indefinite.

Claim 15 recites the limitation "said preview" in line 1. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 7 or "a pop-up preview" of claim 1. Therefore, the claim is vague and indefinite.

Claim 16 depends on claim 15 so claim 16 is rejected on the same rationale.

Claim 36 recites the limitation "said preview" in lines 3-4. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 36 or "a pop-up preview" of claim 23. Therefore, the claim is vague and indefinite.

Claim 37 recites the limitation "said preview" in line 1. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 36 or "a pop-up preview" of claim 23. Therefore, the claim is vague and indefinite.

Claim 38 depends on claim 37 so claim 38 is rejected on the same rationale.

Claim 57 recites the limitation "said preview" in lines 3-4. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 57 or "a pop-up preview" of claim 44. Therefore, the claim is vague and indefinite.

Claim 58 recites the limitation "said preview" in line 1. It is not clear that this "said preview" refers to "a training preview" in line 2 of claim 57 or "a pop-up preview" of claim 44. Therefore, the claim is vague and indefinite.

Claim 59 depends on claim 58 so claim 59 is rejected on the same rationale.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 8-9, 11-12, 17-19, 22-25, 30-31, 33-34, 39-41, 44-46, 51-52, 54-55, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet et al ("Gorbet", USP 6542163) and van Cruyningen (USP 5805167).

Regarding claims 1, 22-23, and 44, Gorbet teaches steps for providing active user feedback (by showing changes in thumbnail in column 3, lines 60-64) in a graphic user interface, said steps comprises selecting a soft control currently displayed on the graphic user interface (selecting button 86A or 86B on the tip balloon 80), wherein said soft control enables a change to be implemented (button 86 A enables the splitting the currently displayed slide into two slides; see column 9, lines 4-9) and displaying on said graphic user interface a preview reflecting said change (a thumbnail reflecting changes; see column 3, lines 60-64). Gorbet differs from the claim in that Gorbet does not teach that the preview is a pop-up feature which is displayed only during said soft control selection. However, such features are known in the art as taught by van Cruyningen. Van Cruyningen teaches steps for allowing directional gestures in a pop up menus for control and data entry in a computer system (see column 3, lines 25-27). Van Cruyningen teaches that the popup menu (see Figure 2) is displayed only upon selection action (popup menu is displayed when mouse button is pressed and is removed when mouse button is released; see column col 8, lines 66-67 and column 9,

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lines 29-32). Since both teachings are in the same field of displaying context sensitive information in an unobtrusive manner to the user (Gorbet; column 1, lines 7-12) (Van Cruyningen; column 1, line 62), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet and Van Cruyningen before him at the time the invention was made, to modify the interface system taught by Gorbet to include the popup menu which is displayed only during selection action taught by Van Cruyningen with the motivation being to avoid covering up part of the work area (Van Cruyningen; column 1, line 62).

Regarding claims 2, 24, and 45, Gorbet teaches the change relates to an attribute of an object capable of being displayed (slides) on the graphical user interface (change some words of a slide from title case to lower case; see column 6, lines 33-36).

Regarding claims 3, 25, and 46, although Gorbet does not explicitly state that the preview display is superimposing a working display area, this limitation is taught inherently since the preview is placed over the area of Microsoft Powerpoint window which is a working display are (see Fig. 2A).

Regarding claims 8, 30, and 51, Gorbet teaches said displaying step is capable of being enabled the preview reflecting change (column 3, lines 60-64).

Regarding claims 9, 31, and 52, Gorbet teaches that said selection step comprises positioning a cursor in a vicinity of the soft control (for selection of one of the action buttons 86A and 86B; see col 9, lines 9-10).

Regarding claims 11, 33, and 54, Gorbet teaches (in column 5, lines 53-58) teaches that a selection can be made by clicking mouser button, therefore, it is inherent

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that Gorbet teaches actively designating said soft control by activating a cursor control (clicking on mouse button when cursor is on buttons 86A or 86B).

Regarding claims 12, 34, and 55, Gorbet teaches that said cursor is positioned using a pointing device 42, and cursor control is a control means associated with said pointing device 42 (see column 7, lines 30-32; also see mouse 42 in Figure 1).

Regarding claims 19, 41, and 62, Gorbet teaches the coupling another soft control to said soft control, wherein the change implementable by the soft control is dependent upon a current setting of the other soft control (edit category may be disabled so that no change will be implemented; see column 3, lines 18-25).

Regarding claims 17-18, 39-40, and 60-61, Van Cruyningen further teaches that the pop up menu can be customized by defining user preferences (column 3, lines 32-37) and the customization comprises setting the nature of the menu (layout).

12. Claims 4-7, 13, 20-21, 26-29, 35, 47-50, 56, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet and van Cruyningen as applied to claims 1, 23, and 44 above, and further in view of Washington et al ("Washington", USP 6515682).

Regarding claims 4, 26, and 47, Gorbet in view of Cruyningen teaches the invention substantially as claimed as specified in claims 1, 23, and 44 above. Gorbet in view of Cruyningen does not teach that the preview display is a composite preview display comprising a present display state and a changed display state. However, such feature is known in the art as taught by Washington. Specifically, Washington teaches steps for editing a control, said steps comprising the displaying a composite display having the control at present display state and a changed display state (in Figure 18,



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the control in a present display state is the control displayed in the middle of Form1 and the control in a changed display state is the control which has slider bar moved from 0 to about 6.2) (see Fig. 9-10 and 14-18; see column 8, lines 40-43). Since both teachings are in the same field of editing in graphical user interface environment (Gorbet; column 3, lines 60-64) (Washington; column 14-16), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet, Van Cruyningen, and Washington before him at the time the invention was made, to modify the interface system taught by Gorbet in view of van Cruyningen to include a composite display having the control at present display state and a changed display state taught by Washington with the motivation being to present the object in both states to enable the user to view and evaluate the changes before applying the change to the object (Washington, column 2, lines 64-67).

Regarding claims 5, 27, and 48, Gorbet teaches that the display states are applied to a symbolic representation of an object displayed on the graphical user interface (a thumbnail is a symbolic representation of a slide; see column 3, lines 60-64).

Regarding claims 6, 28, and 49, Gorbet teaches that the display states are applied to a literal representation of an object displayed on the graphical user interface (words is a literal representation of a slide; see column 6, lines 33-36).

Regarding claims 7, 29, and 50, Washington teaches the transition between the present and changed states (Figure 18 shows the control before the change is applied and Figure 21 shows the control after the change is applied).

Regarding claims 13, 35, and 56, Gorbet in view of van Cruyningen teaches the invention substantially as claimed as specified in claims 11, 33, and 54 above. Gorbet in view of van Cruyningen does teach the adjusting and varying the range of the soft control in relation to a current setting of the soft control. However, such feature is known in the art as taught by Washington. Specifically, Washington teaches steps for editing a control, said steps comprise the adjusting and varying the range of the soft control in relation to a current setting of the soft control (in fig. 18, slider bar moves from 0 to 6.2, therefore range of the control is adjusted and varied). Since both teachings are in the same field of editing in graphical user interface environment (Gorbet; column 3, lines 60-64) (Washington; column 14-16), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet, Van Van Cruyningen, and Washington before him at the time the invention was made, to modify the interface system taught by Gorbet in view of van Cruyningen to include the adjusting and varying the range of the soft control in relation to a current setting of the soft control taught by Washington with the motivation being to present the object in both states to enable the user to view and evaluate the changes before applying the change to the object (Washington, column 2, lines 64-67).

Regarding claims 20-21 and 63-64, Gorbet teaches steps for providing active user feedback (by showing changes in thumbnail in column 3, lines 60-64) in a graphic user interface, said steps comprises selecting a soft control currently displayed on the graphic user interface (selecting button 86A or 86B on the tip balloon 80), wherein said soft control enables a change to be implemented (button 86 A enables the splitting the currently displayed slide into two slides; see column 9, lines 4-9). Gorbet further teaches

the change relates to an attribute of an object capable of being displayed (slides) on the graphical user interface (change some words of a slide from title case to lower case; see column 6, lines 33-36). Gorbet also teaches the displaying on said graphic user interface a preview reflecting said change (a thumbnail reflecting changes; see column 3, lines 60-64). Gorbet does not teach that the preview is a pop-up feature which is displayed only during said soft control selection. However, such feature is known in the art as taught by van Cruyningen. Van Cruyningen teaches steps for allowing directional gestures in a pop up menus for control and data entry in a computer system (see column 3, lines 25-27). Van Cruyningen teaches that the popup menu (see Figure 2) is displayed only upon selection action (popup menu is displayed when mouse button is pressed and is removed when mouse button is released; see column col 8, lines 66-67 and column 9, lines 29-32). Since both teachings are in the same field of displaying context sensitive information in an unobtrusive manner to the user (Gorbet; column 1, lines 7-12) (Van Cruyningen; column 1, line 62), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet and Van Cruyningen before him at the time the invention was made, to modify the interface system taught by Gorbet to include the popup menu which is displayed only during selection action taught by Van Cruyningen with the motivation being to avoid covering up part of the work area (Van Cruyningen; column 1, line 62). Gorbet in view of Cruyningen does not teach that the preview display comprises a present display state and a changed display state. However, such feature is known in the art as taught by Washington. Specifically, Washington teaches steps for editing a control, said steps comprising the displaying a composite display having the control at present display state and a changed display

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state (in Figure 18, the control in a present display state is the control displayed in the middle of Form1 and the control in a changed display state is the control which has slider bar moved from 0 to about 6.2) (see Fig. 9-10 and 14-18; see column 8, lines 40-43). Since both teachings are in the same field of editing in graphical user interface environment (Gorbet; column 3, lines 60-64) (Washington; column 14-16), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet, Van Cruyningen, and Washington before him at the time the invention was made, to modify the interface system taught by Gorbet in view of van Cruyningen to include a composite display having the control at present display state and a changed display state taught by Washington with the motivation being to present the object in both states to enable the user to view and evaluate the changes before applying the change to the object (Washington, column 2, lines 64-67).

13. Claims 10, 32, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet and van Cruyningen as applied to claims 1, 23, and 44 above, and further in view of Tazoe et al ("Tazoe", USP 6326985).

Regarding claims 10, 32, and 53, Gorbet in view of Cruyningen teaches the invention substantially as claimed as specified in claims 1, 23, and 44 above. Gorbet in view of Van Cruyningen does not teach the passively designating said soft control by allowing the cursor to remain in the vicinity of the soft control for a first time period. However, this feature is known in the art as taught by Tazoe. Specifically, Tazoe teaches a method for providing an excellent display apparatus effectively using the display area of the object/window (abstract). Tazoe's teaching comprises that, if the mouse cursor stays in the application window over a time period equal or longer than a

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predetermined time, then return the application window to the active state (passive designation) (column 15, lines 12-17). Since both teachings are in the same field of processing data displayed on screen (Gorbet; column 1, lines 7-12) (Tazoe; column 1, lines 5-17), it would have been obvious to one of ordinary skill in the graphical user interface art, having the teaching of Gorbet, Van Cruyningen, and Tazoe before him at the time the invention was made, to modify the interface system taught by Gorbet in view of van Cruyningen to include the passive designation if the mouse cursor stays in the application window over a time period equal or longer than a predetermined time taught by Tazoe with the motivation being to enable the user/system to conveniently activate a desired object without having to perform the click operation of the mouse button.

14. Claims 14-16, 36-38, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet, van Cruyningen, and Tazoe as applied to claims 10, 32, and 53 above, and further in view of Washington and Jacober et al ("Jacoher", USP 6020886).

Regarding claims 14-15, 36-37, and 57-58, Gorbet, Van Cruyningen, and Tazoe teach the invention substantially as claimed as specified in claims 10, 32, and 53 above. Gorbet, Van Cruyningen, and Tazoe do not teach a transition representing the nominal change between the present display state and the changed display state. However, such feature is known in the art as taught by Washington. Specifically, Washington teaches steps for editing a control, said steps comprising the displaying a composite display having the control at present display state and a changed display state (in Figure 18, the control in a present display state is the control displayed in the middle of

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Form1 and the control in a changed display state is the control which has slider bar moved from 0 to about 6.2) and Washington teaches the transition between the present and changed states (Figure 18 shows the control before the change is applied and Figure 21 shows the control after the change is applied). Since the teachings are in the same field of editing in graphical user interface environment (Gorbet; column 3, lines 60-64) (Washington; column 14-16), it would have been obvious to one of ordinary skill in the art, having the teaching of Gorbet, Van Cruyningen, Tazoe, and Washington before him at the time the invention was made, to modify the interface system taught by Gorbet, van Cruyningen, in view of Tazoe to include the transition between the present and changed states taught by Washington with the motivation being to present the object in both states to enable the user to view and evaluate the changes before applying the change to the object (Washington, column 2, lines 64-67). Gorbet in view of Van Cruyningen does not teach that the preview is a training preview. However, such feature is known in the art as taught by Jacober. Jacober teaches a method for generating animated help demonstrations which comprises a help demonstration player program which guides a user through the steps involved in using a particular feature of a software program (training preview) (line 63 of column 2 to line 4). Since the teachings are in the same field of displaying helpful information to a user (Gorbet, column 1, lines 7-12) (Jacoher, column 1, lines 7-9), it would have been obvious to one of ordinary skill in the graphical user interface art, having the teaching of Gorbet and Van Cruyningen, and Jacober before him at the time the invention was made, to modify the help system taught by Gorbet and van Cruyningen to include the help demonstration program taught by Jacober with the motivation being to educate the user how to manipulate the control,

for example, whether the control should be clicked or double-clicked (see Jacober, column 2, lines 18-22 and lines 52-54).

Regarding claims 16, 38, and 59, Gorbet teaches the displaying step is capable of being enabled the preview reflecting change (column 3, lines 60-64).

15. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

Stone et al (USP 5467441) teaches a method for partially and temporally the objects in a model data structure. Stone further teaches the permission to preview the changes to an image before changes are actually applied.

Andersen et al (USP 5903905) teaches a method for simultaneously constructing and displaying a dynamic preview of a document that provides an accurate customized document.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232). The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-872-9306

and / or:

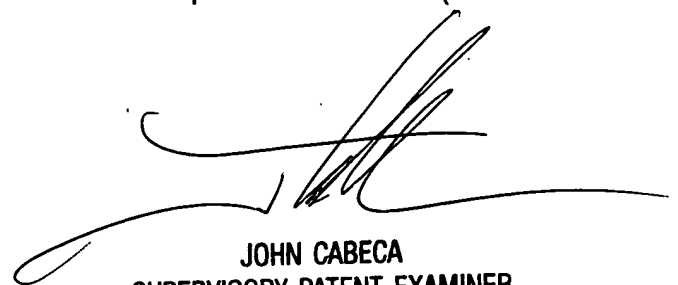
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(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

03/03/04

A handwritten signature in dark ink, appearing to read 'John Cabeca', with a long horizontal flourish extending to the right.

JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100